RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – Art Unit 2171
Attorney Docket No. 108298610US

REMARKS/ARGUMENTS

In the Office Action dated 24 October 2002, the Examiner withdrew claims 52-62 from consideration as being drawn to a non-elected invention and rejected claims 1-51, i.e., all claims considered. This Office Action was also made final.

The undersigned would like to thank Examiner Al-Hashemi for extending the courtesy of a telephonic interview on Thursday, 2 January 2003. Although no final agreement regarding the disposition of these claims was reached during that interview, the undersigned found it helpful in understanding the Examiner's current rejection.

The undersigned questions the logic set forth in support of the present restriction requirement. Given the finality of the present Office Action, though, claims 52-62 have been canceled in the interest of advancing prosecution. Applicants reserve the right to pursue the subject matter of these claims in a divisional application, though.

The grounds for rejection set forth in the present Office Action directly parallel those set forth in the prior Office Action mailed 25 June 2002. As a matter of fact, paragraphs 4-28 of the present Office Action appear to be verbatim or near-verbatim recitations of the rejections set forth in the prior Office Action. paragraph 29 of the present Office Action specifically address the undersigned's arguments in the Amendment filed 12 September 2002 as follows:

> Examiner respectfully traverses applicant's primary arguments.
>
> Referring to claim 1, applicant states that the database is stored on a storage medium different from the medium that stores the audiovisual work. Abecassis does disclose the steps of string [*sic, storing*] data on a different storage by downloading program from the Internet user may save it to the buffer of the PC and then can edit the data on a laser videodisk, which is different storage from the medium that stores the audiovisual (see column 12, lines 1-22, Abecassis).

As discussed in the telephonic interview of 2 January 2003, Abecassis teaches a system for writers, directors, and others who produce videos (e.g., a movie on a laser disk, which cannot be altered) to enable playback of one their videos in different

versions. The content of each version is selected using a "segment map" stored on the same storage medium, e.g., a laserdisk, that contains the video itself. Because the producer creates all of the data stored on this single storage medium, only the producer of the video can define that map. In the context of current DVD technology, for example, Abecassis merely suggests one means for producers (not end users) to generate differently rated versions of the same work using a single pre-recorded DVD. Viewers may be permitted to select from a menu of preset standards for what they prefer to see, but only the producer of the DVD can subjectively rate the content of any part of the video.

As the undersigned explained to the Examiner in the 2 January telephone interview, having a content ratings database or the like on a separate storage medium can afford much more flexibility than Abecassis's single-medium approach. Depending on how it is implemented, this approach can have a number of implications. For example, storing such a database on a separate storage medium avoids any need to alter the video recording itself, yet allows playback to be altered in accordance with certain preferences.

As one non-limiting example, someone within a household, e.g., a parent, can preview an audiovisual work for viewing by younger viewers in the same household. The parent can create a database in which particular scenes are marked for inclusion or removal in the playback of the audiovisual work in accordance with that particular parent's preferences and standards. (See, e.g., page 6, lines 8-11, of the present specification.) This puts the parent, who knows the child, in control of what the child sees instead of deferring to the judgement of a producer or a faceless corporation in Hollywood.

As another non-limiting example, a viewer may buy a movie on DVD and create a database, e.g., on a computer hard drive, that controls playback of that movie. If the viewer lends or sells the movie to someone else, the second user will receive the same, unaltered recording she would get if she rented or purchased the movie from someone

else. Alternatively, the viewer can share his ratings with a third party who has independently rented or purchased her own copy of the same movie. The first viewer may, for example, share this database by uploading it to the Internet where friends or subscribers may access it. The third party's viewing of the movie can then be guided by the first viewer's database.

A. Claims 1-13 and 51

Turning now to the claimed invention, claim 1 calls for a method of creating a playback database containing content ratings level information. Claim 1 requires storing the database on a storage medium **different from the medium that stores the audiovisual work**. Abacassis consistently teaches that the segment map and the video must be distributed and/or stored together on a single medium, e.g., a single pre-recorded laserdisk, so the undersigned respectfully submits that Abacassis cannot anticipate claim 1 and the present rejection of claim 1 under 35 U.S.C. §102(e) must fail. Furthermore, there is nothing in Abecassis that would lead one of ordinary skill in the art to modify the process taught therein to arrive at the invention defined in claim 1. To the contrary, Abacassis teaches away from this claimed process by consistently requiring that the producer define a segment map that is recorded and distributed on a single medium with the movie or other program. As a consequence, claim 1 is also patentably non-obvious over Abecassis under § 103. Claims 2-13 and 51 all depend from claim 1 and are patentable at least by virtue of their dependence from an allowable base claim.

B. Claim 14

Claim 14 provides a method of creating a playback database containing content ratings level information. This process requires "uploading said database to an Internet server independently of" the audiovisual work. Apparently in response to the undersigned's prior argument, the Examiner notes in paragraph 29 of the present Office Action that Abecassis refers to downloading the entire program from the Internet. Abecassis explains two ways of downloading the program at column 13, line 56–

column 14, line 14. In the first approach, the viewer will first specify a "viewer preference structure" and only the edited version of the program resulting from the producer's segment map will be transmitted to the viewer. In the second approach, the entire program and the producer's content map are downloaded and stored together by the viewer.

There are at least two meaningful distinctions between claim 14 and Abecassis's disclosure. First, Abecassis discusses downloading selected information to the viewer, but never mentions the possibility of uploading a content ratings database to an Internet server or the like. The Examiner acknowledges this distinction but contends it would have been obvious to upload the database. Second, the content downloaded by the viewer will either be an edited version of the program without any database or will be downloaded together with the segment map. This is readily distinguishable form the requirement of claim 14 that the database be uploaded independently of the audiovisual work. The Examiner did not address this distinction in the present rejection. The undersigned respectfully submits, though, that the claimed process of uploading the database separately of the audiovisual work goes directly against the consistent thrust of Abacassis's disclosure, which teaches that the segment map and the video should be distributed together as a whole. Consequently, claim 14 is believed to be patentably distinguishable from Abecassis.

C. Claims 15-24

Claim 15 calls for a method of controlling reproduction of an audiovisual work that includes, *inter alia*, accessing a database stored on a storage medium different from the medium that stores the audiovisual work. Again, employing a database stored on a different storage medium is in direct conflict with Abecassis's single-medium approach in which the segment map is distributed on the same recording medium as the program itself. Hence, claim 15 is distinguishable over Abecassis under §102(e). In the absence of some evidence that one of ordinary skill in the art would have been motivated to contradict Abacassis in a fashion to yield the claimed method, claim 15 is

non-obvious over Abacassis under §103, as well. Claims 16-24 depend from claim 15 and are allowable over Abecassis at least on that basis.

D. Claims 25-35

Claim 25 recites an apparatus that includes an input device for assigning a ratings level, a device for creating a database, and a storage medium different from the medium that stores the audiovisual work for storing the database. Abecassis, as noted previously, stores the producer-generated segment map on the same laserdisk or other medium used to distribute the program. As a result, claim 25 is believed to be both distinguishable under § 102(e) and non-obvious under § 103 over Abecassis. Claims 26-35 depend from claim 25 and are patentable at least by virtue of their dependency from claim 25.

E. Claims 36-44

Claim 36 calls for an apparatus for controlling playback of an audiovisual work. This apparatus includes a device for accessing a database stored at a first location and a reproduction unit for reproducing scenes of an audiovisual work from a second location in accordance with information in the database. Employing a device to access a database from a first location and a production unit which reproduces a work from a second location differs from Abecassis's single-medium approach. By analogy to the arguments set forth above, therefore, claim 36 and dependent claims 37-44 are patentable over Abecassis.

F. Claims 45-50

Claim 45 calls for an audiovisual playback apparatus that includes a recording medium separate from an audiovisual medium and a database stored on the recording medium that can be used to control reproduction of the audiovisual work. Again, having a database on a recording medium that is separate from the audiovisual medium directly contradicts Abecassis's consistent teachings. As a consequence, claim 45 and dependent claims 46-50 are patentable over Abecassis.

G. Conclusion

In view of the foregoing, the undersigned submits that the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. As the present amendment is believed to place the application in condition for allowance, entry of the amendment is proper under 37 C.F.R. § 1.116 despite the finality of the outstanding Office Action and a Notice of Allowance is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at 206.264.3848.

Respectfully submitted,
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